

ESTTA Tracking number: **ESTTA654614**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91219959
Party	Defendant Fitness Publications, Inc.
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Submission	Answer and Counterclaim
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Date	02/06/2015
Attachments	ANSWER - Fitness adv Univ Nutrition.pdf(395648 bytes)

Registration Subject to the filing

Registration No	4483690	Registration date	02/18/2014
Registrant	Universal Protein Supplements Corporation 3 Terminal Road New Brunswick, NJ 08901 UNITED STATES		

Goods/Services Subject to the filing

Class 005. First Use: 1998/00/00 First Use In Commerce: 1998/00/00 All goods and services in the class are requested, namely: Nutritional supplements for human consumption
Class 025. First Use: 1998/00/00 First Use In Commerce: 1998/00/00 All goods and services in the class are requested, namely: Clothing, namely, hats, caps, bottoms, tops, shorts, pants, shirts, sweat shirts, sweat pants, sweat shorts, sweat jackets
Class 035. First Use: 1998/00/00 First Use In Commerce: 1998/00/00 All goods and services in the class are requested, namely: On-line retail store services featuring health and diet-related products

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Universal Protein Supplements
Corporation dba Universal Nutrition,

Opposer,

VS.

Fitness Publications, Inc.,

Applicant.

Opposition No. 91219959



Mark:


Serial No.: 86/026,728

Filing Date: August 01, 2013

ANSWER

Fitness Publications, Inc., a California corporation (“Fitness Publications”)
hereby answers the Notice of Opposition (“Opposition”) filed by Universal Protein
Supplements Corporation dba Universal Nutrition (“Universal Nutrition”) against



U.S. Serial No. 86/026,728 for the mark  (the “**Fitness Silhouette Mark**”).

Fitness Publications does not believe that any response to the introductory paragraph is required; however, to the extent that the Board determines that the introductory paragraph contains factual allegations, Fitness Publications is without knowledge or information sufficient to form a belief as to the truth of any of the allegations and, on that basis, denies those allegations.

1. Fitness Publications is without knowledge or information sufficient to form a belief as to the truth of any of the allegations of paragraph 1 and, on that basis, denies those allegations.

2. Fitness Publications admits: (a) that U.S. Reg. No. 4,483,690 (the



“UN Registration”) is for the mark ; (b) that the UN Registration issued on or about February 18, 2014, that the UN Registration lists “Nutritional supplements for human consumption” in International Class 5, “Clothing, namely, hats, caps, bottoms, tops, shorts, pants, shirts, sweat shirts, sweat pants, sweat shorts, sweat jackets” in Class 25, and “On-line retail store services featuring health and diet-related products” in Class 35; (c) that a first use date of 1998 was claimed by the applicant in the original application for the UN Registration; and (d) that, as of the filing date of this Answer, “Universal Protein Supplements Corporation dba Universal Nutrition” is listed as owner of the UN Registration in the U.S. Patent & Trademark Office database. With respect to the remaining allegations in Paragraph 2, Fitness Publications is without knowledge or information sufficient to form a belief as to the truth of any of the allegations and, on that basis, denies those allegations.

3. Fitness Publications is without knowledge or information sufficient to form a belief as to the truth of any of the allegations of paragraph 3 and, on that basis, denies those allegations.

4. Fitness Publications is without knowledge or information sufficient to form a belief as to the truth of any of the allegations of paragraph 4 and, on that basis, denies those allegations.

5. Fitness Publications is without knowledge or information sufficient to form a belief as to the truth of any of the allegations of paragraph 5 and, on that basis, denies those allegations.

6. Fitness Publications realleges and incorporates by references its responses to the allegations of paragraphs 1 through 5 as if fully set forth herein.

7. Fitness Publications admits that it filed Application Serial No. 86/026,728 on or about August 1, 2013, and that the application included “Dietary and nutritional supplements” in International Class 5. Fitness Publications admits that in an Allegation of Use, filed on or about November 19, 2013, Fitness Publications claimed first use of the Fitness Silhouette Mark at least as early as October 2, 2013. With respect to the remaining allegations in Paragraph 7, Fitness Publications is without knowledge or information sufficient to form a belief as to the truth of any of the allegations and, on that basis, denies those allegations.

8. Denied.

9. Fitness Publications is without knowledge or information sufficient to form a belief as to the truth of any of the allegations of paragraph 4 and, on that basis, denies those allegations.

10. Denied.

11. Denied.

AFFIRMATIVE DEFENSES

12. The Fitness Silhouette Mark is an actual likeness of Arnold Schwarzenegger, who is famous internationally as a professional bodybuilder. The likeness of Arnold Schwarzenegger is inherently distinctive. The average consumer is likely to associate the Fitness Silhouette Mark with Arnold Schwarzenegger.

13. Fitness Publications incorporates the allegations of the counter-claims reference below.

14. Fitness Publications hereby reserves the right to amend its answer to raise additional affirmative defenses as they become available or apparent to Fitness Publications through discovery in this matter or otherwise.

COUNTERCLAIM FOR CANCELLATION

15. Fitness Publications believes it is being damaged and will continue to be damaged by the maintenance of U.S. Registration No. 4,483,690 on the Principal Register.

16. Universal Nutrition has relied upon U.S. Registration No. 4,483,690 as a basis for opposing registration of the Fitness Silhouette Mark on the grounds of priority and likelihood of confusion under Section 2(d) of the Trademark Act.

17. Fitness Publications hereby petitions to cancel U.S. Registration No. 4,483,690, and, as grounds for cancellation, alleges as follows:

Fitness Publication's Famous "Arnold" Names and Marks

18. Arnold Schwarzenegger is a world famous actor, former governor of California, businessman, and former professional bodybuilder.

19. Schwarzenegger began weight training as a teenager, and won his first title in 1965. In 1967, at age 20, he first won the "Mr. Universe" title; he went on to win the "Mr. Universe" competition four more times. Schwarzenegger also held the title of "Mr. Olympia" seven times, most recently in 1980. The 1977 film *Pumping Iron* documents the story of Schwarzenegger's preparation for the "Mr. Olympia" contest. A 25th anniversary edition of the film was released in 2003.

20. Schwarzenegger is a published authority on the subject of bodybuilding. His books include:

- *Arnold: The Education of a Bodybuilder* (Simon & Schuster; 1977);
- *Arnold's Bodyshaping for Women* (Simon & Schuster, 1979);
- *Arnold's Bodybuilding for Men* (Simon & Schuster, 1981);

- *The Encyclopedia of Modern Bodybuilding* (Simon & Schuster; 1985);
- *Arnold's Fitness for Kids* (Doubleday, 1993); and
- *The New Encyclopedia of Modern Bodybuilding : The Bible of Bodybuilding* (Simon & Schuster; 1988).

21. Schwarzenegger's name and image are iconic in the sport of bodybuilding. Since 1989, Schwarzenegger's legacy has been commemorated annually in the "Arnold Classic" bodybuilding competition. He has been depicted on the cover of more than 1,000 magazines, many of which were associated with bodybuilding, sports, and fitness. In the early 1990s, Schwarzenegger was featured in a weekly fitness Q&A column in *USA Weekend* entitled "Ask Arnold" which reached 33.5 million readers. He has made hundreds of film and television appearances as himself. He has also released videos in the fields of bodybuilding and fitness, including "Shape Up With Arnold", which was released in 1983. For many years, Schwarzenegger wrote a monthly column for *Muscle & Fitness* and *Flex*, and he is currently serving as executive editor of both publications.

22. The name ***and the likeness*** of Schwarzenegger (including without limitation the following likenesses) are famous with respect to bodybuilding.




23. Schwarzenegger's name and likeness have been famous with respect to bodybuilding since prior to since prior to the filing date of Universal Nutrition's application to register the mark depicted in the UN Registration, as well as prior to the date of first use of that mark claimed by Universal Nutrition in its application to register the UN Registration.

24. Since retiring from the sport of bodybuilding, Schwarzenegger has achieved celebrity as a film and television actor, and as the Governor of California from 2003 until 2010.


25. Schwarzenegger is a recognized authority in the areas of fitness and nutrition. The Arnold Fitness Expo – held during the annual Arnold Sports Festival – features over 800 exhibition booths showcasing the latest in sports equipment, apparel, and nutrition as well as a stage that hosts unique, non-stop competitions, and entertainment.

26. With the consent of Schwarzenegger, Fitness Publications has obtained federal trademark protection for Schwarzenegger's name and likeness

and it is the owner of the following federal trademark registrations, among others (the “Schwarzenegger Image Registrations”):

Mark	Registration Date	Reg. No.	Goods/Services
	4/20/2004	2833705	Clothing and headwear, namely, t-shirts, shirts
THE ARNOLD SCHWARZENEGGER CLASSIC	12/19/1989	1572499	Entertainment services in the nature of weightlifting and body building competitions
ARNOLD CLASSIC	2/13/2007	3208453	Entertainment services in the nature of fitness and bodybuilding competitions
ARNOLD SPORTS FESTIVAL	1/2/2007	3192055	Entertainment in the nature of demonstrations of athletic skills

27. With the consent of Schwarzenegger, Fitness Publications has also applied for federal trademark protection of Schwarzenegger’s name and likeness, including the pending applications listed below (the “Schwarzenegger Image Applications”)(collectively, with the Schwarzenegger Image Registrations, the “Schwarzenegger Image Marks”):

Mark	Filing Date	Serial No.	Goods/Service
	8/1/2013	86026728	Dietary and nutritional supplements.
ARNOLD	1/6/15	86496501	Dietary and nutritional supplements
ARNOLD SCHWARZENEGGER	8/1/2013	86026727	Dietary and nutritional supplements.
ARNOLD SCHWARZENEGGER MUSCLE BAR	7/18/2014	86340887	Nutritional supplements, namely, high-protein bars.
ARNOLD SCHWARZENEGGER BLUEPRINT	2/18/2014	86197124	Dietary and nutritional supplements; Educational services, namely, conducting classes and programs in the field of fitness and nutrition; physical education; physical fitness education and training; providing information in the field of fitness and nutrition; Dietary and nutritional guidance; providing information about dietary supplements and nutrition
ARNOLD SCHWARZENEGGER BLUEPRINT TO CUT	2/18/2014	86197131	Dietary and nutritional supplements; Educational services, namely, conducting classes and programs in the field of fitness and nutrition; physical education; physical fitness education and training; providing information in the field of

Mark	Filing Date	Serial No.	Goods/Service
			fitness and nutrition; Dietary and nutritional guidance; providing information about dietary supplements and nutrition
ARNOLD SCHWARZENEGGER BLUEPRINT TO MASS	2/18/2014	86197133	Dietary and nutritional supplements; Educational services, namely, conducting classes and programs in the field of fitness and nutrition; physical education; physical fitness education and training; providing information in the field of fitness and nutrition; Dietary and nutritional guidance; providing information about dietary supplements and nutrition

28. Fitness Publications has used some of the Arnold Marks in commerce in the United States in connection with the goods and services listed in the registration certificates since prior to the filing date of Universal Nutrition's application to register the mark depicted in the UN Registration, as well as prior to the first use date claimed by Universal Nutrition in the mark depicted in the UN Registration.

Universal Nutrition's Bodybuilder Design

29. Universal Nutrition's mark which is the subject of the UN Registration depicts the silhouette of a flexing male bodybuilder.

30. On its website at www.universalusa.com, Universal Nutrition describes its brand as the “one name that is on the lips of serious and dedicated bodybuilders intent on sculpting and chiseling that perfect physique.” The goods and services in Universal Nutrition’s registration are all related to bodybuilding and marketed and advertised specifically to the bodybuilding community.

31. Neither Arnold Schwarzenegger nor Fitness Publications is connected with the activities performed by Universal Nutrition under the mark depicted in the UN Registration. Neither Arnold Schwarzenegger nor Fitness Publications has authorized or consented to registration of the mark in the UN Registration.

Merely Descriptive
(Trademark Act Section 2(e)(1))

32. Whereas the Fitness Silhouette Mark depicts the likeness of the famous bodybuilder Arnold Schwarzenegger, the mark in the UN Registration merely depicts a generic bodybuilder silhouette.

33. Upon information and belief, it is relatively common in the marketplace to use the image or design of a bodybuilder in connection with goods and/or services targeting to the bodybuilding community.

34. As used on and in connection with the offering of goods and services intended for use by bodybuilders, the mark in the UN Registration is merely descriptive.

Failure To Function As A Mark
(Trademark Act Section 1)

35. The mark depicted in the UN Registration does not function as a trademark for the goods and services listed in the registration, but is merely ornamental or informational as applied to Universal Nutrition's goods and services.

36. Upon information and belief, Universal was not using the bodybuilder design as a mark as of the filing date of its application to register the mark with the U.S. Patent & Trademark Office.

37. Upon information and belief, Universal was not using the bodybuilder design as a mark as of the date of first use claimed by Universal in its application to register the mark with the U.S. Patent & Trademark Office.

38. Upon information and belief, consumers are not likely to view Universal Nutrition's bodybuilder design as signifying the source or origin of the goods or services in connection with which it is used.

False Suggestion Of A Connection
(Trademark Act Section 2(a))

39. Arnold Schwarzenegger's likeness and identity was famous prior to both the January 8, 2013 filing date of the application for federal registration of Universal Nutrition's bodybuilder design and the 1998 date of first use in commerce claimed by Universal Nutrition in its application.

40. Universal Nutrition claims in its Notice of Opposition filed on December 29, 2014 that the mark in its UN Registration and the Fitness Silhouette Mark are likely to be confused by the public. If this contention were accurate, then such confusion would be likely only because Universal Nutrition's mark is a close approximation of Schwarzenegger's likeness and/or identity. Schwarzenegger's fame and reputation is such that, when a mark approximating his likeness and identity is used without his authorization or consent on Universal Nutrition's bodybuilding-related goods or services, a connection with Schwarzenegger and/or Fitness Publications would be presumed.

41. Upon information and belief, if the allegations of Universal Nutrition are true, then Universal Nutrition's selection of the mark depicted in U.S. Reg. No. 4,483,690 was intended to and/or does create a false association with Schwarzenegger.

PRAYER FOR RELIEF

WHEREFORE, Fitness Nutrition respectfully prays:

A. That Universal Nutrition's petition be denied and this Opposition Proceeding be dismissed;

B. That U.S. Registration No. 4,483,690 be cancelled and that Fitness Nutrition's Petition For Cancellation be sustained in favor of Fitness Nutrition;

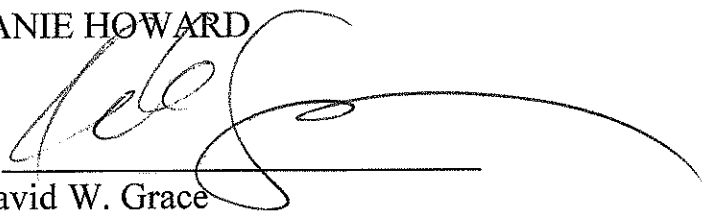
C. In the alternative, that U.S. Registration No. 4,483,690 be partially cancelled with respect to International Class 5, International Class 25 and/or International Class 35.

The filing fee is being submitted with this petition. Please charge any deficiency or credit any overpayment to Deposit Account 12-1820.

Dated: February 6, 2015

Respectfully submitted,

LOEB & LOEB LLP
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Fitness Publications, Inc.

CERTIFICATE OF SERVICE AND MAILING

It is hereby certified that a copy of the foregoing ANSWER AND COUNTERCLAIM is being deposited with the United States Postal Service, first-class postage prepaid, in an envelope addressed to:

Maureen Beacom Gorman
Marshall Gerstein & Borun LLP (31742-12282-L)
233 South Wacker Drive Suite 6300
Chicago, IL 60606

Executed this 6th day of February 2015 at Los Angeles, California.



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